

**Appl. No.** : 10/509,793  
**Filed** : September 30, 2004

### **REMARKS**

Claims 3 and 6-8 have been canceled without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the canceled claims in this or any other patent application.

Claims 2, 4, 5, 9-11 and 14 are amended herein. The amendment to Claims 2 and 5 is supported by the specification, for example, at page 26, lines 2-19. The amendment to Claim 4 is supported by the specification, for example, at page 42, lines 1-4. The amendment to Claims 9 and 14 is supported by the specification, for example, at page 22, line 16, through page 23, line 14. Claim 10 is amended to independent form without modifying its scope. Claim 11 is amended to modify its dependency. The amendment to Claim 17 is supported by the specification, for example, at page 17, lines 10-14 and at page 38, line 23, through page 39, line 1.

New Claims 20-23 are added. New Claim 20 is supported by the specification, for example, at page 42, lines 1-4. New Claims 21-23 are supported, for example, by original Claims 11-13.

No new matter is added by the amendments and new claims.

Upon entry of the amendment, Claims 1, 2, 4, 5 and 9-23 are pending.

### **Rejection Under 35 U.S.C. §101**

Claims 6 and 7 have been rejected under 35 U.S.C. §101, as being drawn to non-statutory subject matter.

Claims 6 and 7 are canceled herein. Accordingly, this ground for rejection of the claims is now moot.

### **Rejection of Claims 3 and 4 Under 35 U.S.C. §102(b or e)**

Claims 3 and 4 are rejected under 35 U.S.C. §102(b or e) as anticipated by Dages, DeTora, Doyel, Greenfield, Nissan Motor or Shiseido.

Applicants respectfully traverse the rejection.

Claim 3 is canceled herein. Accordingly, the rejection of this claim is moot.

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Claim 4 is amended to encompass only 3 compounds described in the Examples of the specification. These 3 compounds are not disclosed in any of cited references. Therefore, amended Claim 4 is not anticipated by above cited references.

New Claim 20 also recites the same 3 compounds as amended Claim 4. Accordingly, Claim 20 also is novel over above cited references.

**Rejection of Claims 3, 4, 8, 9 and 11-16 Under 35 U.S.C. §102(b or e)**

Claims 3, 4, 8, 9 and 11-16 are rejected under 35 U.S.C. §102(b or e) as anticipated by Matsushita or Mitsui Chemicals.

Claims 3 and 8 are canceled. Accordingly, the rejections of these claims are moot.

Claim 4 is amended to encompass only 3 compounds described in the Examples of the specification. These 3 compounds are not disclosed in Matsushita or Mitsui Chemicals. Therefore, amended Claim 4 is not anticipated by Matsushita or Mitsui Chemicals.

Claims 9 and 14 are amended to comprise, as plasticizer, an ester compound of obtained by reacting a dibasic acid with an ether alcohol and/or an ester compound obtained by reacting a dibasic acid with an ether alcohol and benzyl alcohol.

Correspondingly, Matsushita and Mitsui Chemicals use, as plasticizer, an ester compound obtained by reacting a dibasic acid with an alcohol or an ester compound obtained by reacting a dibasic acid with an alcohol and benzyl alcohol.

Matsushita and Mitsui Chemicals do not disclose, as plasticizer, an ester compound obtained by reacting a dibasic acid with an ether alcohol or an ester compound obtained by reacting a dibasic acid with an ether alcohol and benzyl alcohol. Therefore, amended Claim 9, Claims 11-13 depending from Claim 9, Claim 14, and Claims 15 and 16 depending from Claim 14, are not anticipated by Matsushita or Mitsui Chemicals.

**Rejection of Claims 2, 3 and 5 Under 35 U.S.C. §102(b or e)**

Claims 2, 3 and 5 are rejected under 35 U.S.C. §102(b) as anticipated by Sarbach or Geary.

Claim 3 is canceled herein. Accordingly, the rejection of this claim is moot.

Claims 2 and 5 are amended to encompass specific citrates and acetylates of these citrates.

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Neither Sarbach nor Geary discloses these specific citrates or acetic acid esters thereof. Therefore, amended Claims 2 and 5 are not anticipated by Sarbach or Geary.

#### New Claims

New Claims 20-23 are added herein.

New Claim 20 recites the same 3 compounds as amended Claim 4. These compounds are not disclosed in the cited references. Accordingly, Claim 20 is novel over the cited references.

New Claims 21-23 are directed to the biodegradable resin composition of Claim 10. Claim 10 is patentable over the cited references; accordingly, Claims 21-23 dependent therefrom also are patentable.

#### CONCLUSION

In light of the Applicant's foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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